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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,947	12/26/2001	Hsuan-Yin Lan-Hargest	12938-003002	8464
27890	7590	12/05/2006	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			ZUCKER, PAUL A	
			ART UNIT	PAPER NUMBER

1621

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/025,947	<b>Applicant(s)</b> LAN-HARGEST ET AL.	
	<b>Examiner</b> Paul A. Zucker	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26,80-94,96,97 and 99-103 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,8,12,13,16,17,22,25,26,80-94,96,97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 September 2006 has been entered.

### ***Current Status***

2. This action is responsive to Applicants' amendment of 28 June 2002 in Paper No 10.
3. Receipt and entry of Applicants' amendment is acknowledged.
4. Applicant's cancellation of claims 6, 9-11, 14-15, 18-21, 23-24, 27-79, 95 and 98 is acknowledged.
5. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.
6. The rejections under 35 USC § 112, first paragraph, set forth in paragraph 5 of the previous Office Action mailed 9 May 2006 is withdrawn in response to Applicants' amendment.
7. The rejection under 35 USC § 102 set forth in paragraph 8 of the previous Office Action mailed 9 May 2006 is withdrawn in response to Applicant's remarks.

Art Unit: 1621

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***New Objections and Rejections***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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***Specification***

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-5, 7, 8, 12, 13, 16, 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 sets forth the limitations "Y<sup>2</sup> is CH<sub>2</sub> or a bond" in line 14 and "when L contains zero double bonds, one double bond, or two conjugated double bonds and A is C3-14 cycloalkyl, substituted phenyl or unsubstituted aryl, Y<sup>1</sup> is not a bond or CH<sub>2</sub> and Y<sup>2</sup> is not a bond or CH<sub>2</sub> " in lines 27-29. When the last limitation is met Y<sup>2</sup> is undefined. Claim 1 and

Art Unit: 1621

its dependents are therefore rendered indefinite. Claim 1 and its dependents are therefore rendered indefinite.

10. Claims 22, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 sets forth the limitations "Y<sup>2</sup> is CH<sub>2</sub> or a bond" in line 10 and "when L contains zero double bonds, one double bond, or two conjugated double bonds and A is C3-14 cycloalkyl, substituted phenyl or unsubstituted aryl, Y<sup>1</sup> is not a bond or CH<sub>2</sub> and Y<sup>2</sup> is not a bond or CH<sub>2</sub> " in lines 19-20. When the last limitation is met Y<sup>2</sup> is undefined. Claim 22 and its dependents are therefore rendered indefinite.

11. Claim 102 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 102 sets forth the limitations "Y<sup>2</sup> is CH<sub>2</sub> or a bond" in line 13 and "when L contains zero double bonds, one double bond, or two conjugated double bonds and A is C3-14 cycloalkyl, substituted phenyl or unsubstituted aryl, Y<sup>1</sup> is not a bond or CH<sub>2</sub> and Y<sup>2</sup> is not a bond or CH<sub>2</sub> " in lines 25-28. When the last limitation is met Y<sup>2</sup> is undefined. Claim 102 is therefore rendered indefinite.

12. Claims 5, 17, 26, 84, 90 and 101 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims assign an

Art Unit: 1621

identity (to  $Y^2$  that is other than  $CH_2$  or a bond. There is insufficient antecedent basis for those limitations in the claims.

***Claim Rejections - 35 USC § 102***

13. Claims 1-5, 12, 13, 22 and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleming et al (Chemical Communications, Decarboxylative Elimination of Enol Triflates as a General Synthesis of Acetylenes, 1999, pages 1113-1114). Fleming discloses (Page 11113, column 2, top) compound **4a**, 5-phenyl-pent-2-ynoic acid which corresponds to an instantly claimed compound. Fleming therefore anticipates claims 1-5, 12, 13, 22 and 102.
14. Claims 1-5, 7, 8, 22, 25, 26, 80-86, 89-94, 96, 97, and 100-103 are rejected under 35 U.S.C. 102(b) as being anticipated by Herold et al (US 5, 010,189 04-1991). Herold discloses (Column 30, lines 2-7) the compound 6-cyclohexyl-2-phenyl-4-hexenoic acid which is an instantly claimed compound wherein L is substituted with monocyclic aryl. Since no specific double bond geometry is disclosed the Examiner assumes that both isomers are present. Fleming further discloses (Column 29, lines 9-14) an aqueous solution of the compound corresponding to a pharmaceutical composition. Herold therefore anticipates claims 1-5, 7, 8, 22, 25, 26, 80-86, 89-94, 96, 97, and 100-103.
15. Claims 1-5, 7, 8, 12, 13, 22, 25, 26, 80-90, and 102 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker et al (US 4,513,005 04-1985). **NOTE:** Due to its indefinite nature (see above) the Examiner considers the proviso concerning  $Y^2$  inoperative for the purposes of this rejection. Baker discloses the

Art Unit: 1621

compound (E)-8-phenyloctenoic acid and its aqueous solution corresponding to a pharmaceutical composition.

**Conclusion**


16. Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are pending.

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, 80-94, 96, 97 and 99-103 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
PAULA A. ZUCKER, PH.D.  
PRIMARY EXAMINER  
